



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
PO. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,371	02/26/2002	Thomas W. Hagler	M-10489-3P US	2871

36257 7590 09/15/2003  
PARSONS HSUE & DE RUNTZ LLP  
655 MONTGOMERY STREET  
SUITE 1800  
SAN FRANCISCO, CA 94111

EXAMINER
----------

SMITH, ZANDRA V

ART UNIT	PAPER NUMBER
----------	--------------

2877

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)	
09/869,371	HAGLER, THOMAS W.	
Examiner	Art Unit	
Zandra V. Smith	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_ .

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 102-131 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_ is/are allowed.

6) Claim(s) 102-131 is/are rejected.

7) Claim(s) \_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ .

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_ .

## **DETAILED ACTION**

### ***Preliminary Amendment***

The preliminary amendment file 27 June 2001 has been entered.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-30 been renumbered 102-131. please note that the office action will refer to the renumbered claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 102, 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Krause (4,448,529)*** in view of ***van den Bosch (3,922,092)***.

As to **claims 102 and 104**, Krause discloses a system for spectral analysis of a beam of radiation, comprising:

first optics (26) for collecting and focussing radiation from a radiation source to form at least two images;

a two dimensional spatial light modulator (11) rotated about a rotation axis and positioning the encoding plane, (col. 5, lines 30-50 and col. 10, lines 30-35); a detector (13); and a processing circuit (col. 5, lines 55-60). Krause differs from the claimed invention in that the modulator does not include individual filter elements, however since the modulator may be a rotating chopper disk and since van den Bosch discloses the use of filters in a rotating chopper disk (col. 5, lines 15-20), it would have been obvious to one having ordinary skill in the art at the time of invention to include filters as a means to ensure that the light is correctly separated.

In addition, Krause provides second optics as an alternative (col. 5, lines 25-30). It would have been obvious to one having ordinary skill in the art at the time of invention to include second optics to ensure the light is correctly focused onto the detector.

Additionally, Krause does not provide a computer, however it would have been obvious to one having ordinary skill in the art at the time of invention since Krause provides a processing circuit and since the provision of a computer would amount to modernization.

Claims 127-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chance (3,811,777)*.

As to **claims 127-128**, Chance discloses a fluorometer and reflectometer, comprising: one or more excitation sources (12); first optics, second and third optics (21-29) for directing, collecting and focusing, a two dimension spatial radiation modulator (13), and a signal processing circuit (col. 4, lines 10-50 and col. 6, lines 49-55).

Chance does not provide a computer, however it would have been obvious to one having ordinary skill in the art at the time of invention since Krause provides a processing circuit and since the provision of a computer would amount to modernization.

***Double Patenting***

Claims 102-126 and 130-131 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,338,794. Although the conflicting claims are not identical, they are not patentably distinct from each other because '794 provides the claimed structure, specifically, a light source, two dimensional spatial radiation modulator, a detector, first, second, and third optics, and a computer.

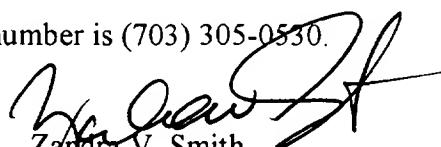
Claims 127-128 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-33 of U.S. Patent No. 6,271,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because '794 provides the claimed structure, specifically, one or more excitation a light sources, two dimensional spatial radiation modulator, a detector, first, second, and third optics, and a computer.

***Fax/Telephone Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zandra V. Smith whose telephone number is (703) 305-7776. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on (703)308-4881. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0530.



Zandria V. Smith  
Primary Examiner  
Art Unit 2877